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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,010	12/21/2001	Gregory L. Renda	1270	2780
30748	7590	03/14/2005	EXAMINER	
INNOVATION PARTNERS 540 UNIVERSITY DRIVE SUITE 300 PALO ALTO, CA 94301			SHAH, KAMINI S	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,010	Applicant(s) RENDA ET AL.	
	Examiner Kamini S. Shah	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 8, 15 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 23 and 34 of copending Application No. 10/027,011. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims at present application includes limitation of claims in '011 such as method of forwarding a communication (selectively providing access to a network) comprising: receiving communication having source identifier (device identifier); retrieving at least one of said indication (providing a request for a set of at least one privileges, and receiving the request for the set of privileges); responsive to the at least one indication retrieved.....the source identifier received with the communication (responsive to the device identifierthe set of privileges requested). The only difference between claim 1 of present application and the claim 1 of '011 is the present application claims first

state and second state, wherein claim in the co-pending application discloses a set of privileges, by eliminating the additional function of the method step, or means for system and/or apparatus claim. However, claims at present application for claiming more than one state such as first and second, is obvious and providing similar function as to the sets of privileges. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to disclose the variation of the state for the outcome of the same result without having effect on its function.

2. Similarly, claims 8,15 and 22 of present application and the claims 12, 23, and 34 of co-pending applications are different in the similar way as in for claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first state" "second state" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: Related application's serial number is missing on pages 1 and 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for network access points, privileges of a class, does not reasonably provide enablement for a first state and a second state. The specification does not enable any person skilled in the art to which it pertains, or with

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which it is most nearly connected, to use the invention commensurate in scope with these claims. The feature as claimed "receiving for each of a plurality of users an indication having one selected from a first state and a second state" does not enable any skilled person in the art to refer to access points or privileges of class as in specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 14, 16-21 recites the limitation "the system of claim 1" in claim 14, and "the computer program product of claim 1 in claims 16-21. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-13, 15, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Keeler, Jr. et al., US 6,502,130.

Regarding to claimed invention of claims 1 and 22, as best understood, a method and an apparatus of forwarding communication comprising: receiving for each of users a identification, Keeler Jr. et al teaches *a system and method which collects dynamic*

connectivity data from an area network interconnecting multiple computing devices; receiving the communication having a source identifier, "The connectivity data identifying the address equipment connected to the network is combined with static network information such as the user's identity stored in the system data bases to relate the connectivity data to the respective users and their respective privileges", as disclosed in Abstract.

A method further comprising retrieving at least one indications; an responsive to the at least one indication retrieved having the first state, forwarding the communication with the source identifier; and responsive to the indication retrieved having the second state, forwarding the communication with an alternate source identifier, Keeler Jr. et al teaches *segment 12 connected to a controller 24, a communications over the SNA network 25 utilize the SNA protocol, and the identity of any workstation having privileges to communicate over the SNA network 25 stored as an SNA XID which provides alternative identity of the workstations, see col. 2, lines 40-52.*

Regarding to claims 2-4, 6-7, and 10-13 Keeler Jr. et al teaches *physical or MAC address for the authorized workstations which is used in the SNA network 25, and MAC address is used on the network segment 12 by controller 24, see col. 2, lines 48-52.*

Regarding claimed communication comprising a packet as in claim 5, Keeler disclose *the router, as is known in standard network architecture, provides bridge from the first*

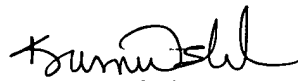
segment to the second segment for transferring data between segments, see col. 2, lines 34-40.

Regarding claims 8 and 9, claims recites similar features in system form as in method claim 1, and additionally recites the an access point manager and network address translation manager, Keeler Jr. et al teaches *network manager 27 which keeps router list containing the community name for the router, as well as MAC address which is used in collection process for obtaining connectivity data from each router*, see col. 2, lines 53-59.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S. Shah whose telephone number is 571-272-2279. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kamini S Shah
Primary Examiner
Art Unit 2142

KSS